

01/14/2009

Attorney's Docket No. 003364.P212

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Ye-Sun Joung, et al.

Application No. 10/532,571

Filed: January 23, 2006

For: **DEVICE AND METHOD FOR EDITING,  
AUTHORING, AND RETRIEVING OBJECT-BASED  
MPEG-4 CONTENTS**

Examiner: Jeremy D. Engelskirchen

Art Unit: 2168

Confirmation No.: 6863

**RESPONSE TO ADVISORY ACTION**

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In the Advisory Action mailed December 22, 2008, the Examiner contends the proposed amendments raise new issues that would require further consideration and/or search.

In response, Applicant notes that the only amendment presented is the cancellation of Claims 10-12, which clearly does not raise a new issue that would require further consideration and/or search.

At page 2 of the Advisory Action, the Examiner contends that the "filing of the Certified Translation after a Final rejection is considered new evidence and will require further search and/or consideration." In response, since Applicant timely submitted a claim for priority and certified copy of the foreign application, Applicant's priority date was of record at the time the Examiner conducted the search, and therefore, no further search is required. As to the Examiner's contention that further consideration is required, Applicant notes that pursuant to 37 C.F.R. 1.55, (a)(4)(i), an English translation of a non-English language foreign application is not required except "when necessary to overcome the date of a reference relied upon by the Examiner...". There is no rule which requires filing of the verified English Translation before issuance of a Final Office Action, and the MPEP also does not contain any such requirement. Presumably, the reason no such requirement exists is that the mere filing of a verified